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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|--------------------------|----------------------|------------------|
| 10/029,673 | 12/31/2001 | Frederique Ehrmann-Patin | 1807.1934 | 5073 |
| 5514 | 7590 | 02/07/2005 | EXAMINER | |
| FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112 | | | NAKHJAVAN, SHERVIN K | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2621 | |

DATE MAILED: 02/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|----------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/029,673 | EHRMANN-PATIN ET AL. | |
| | Examiner | Art Unit | |
| | Shervin Nakhjavan | 2621 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 15,17,19-23,25,27-30,34,38,42,46 and 49 is/are allowed.
- 6) ☒ Claim(s) 1-14,16,18,24,26,31-33,35-37,39-41,43-45,47,48 and 50-52 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4-3-02.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Specification

1. The abstract of the disclosure is objected to because it contains additional text (i.e Title of the invention and figure 9). Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 31, 32, 35, 36, 39, 40, 43 and 44 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In single means claims above, i.e., where a means recitation does not appear in combination with another recited element of means, is subject to an undue breadth rejection under 35 U.S.C. 112, first paragraph. In re Hyatt, 708 F.2d 712, 714-715, 218 USPQ 195, 197 (Fed. Cir. 1983) (A single means claim which covered every conceivable means for achieving the stated purpose was held nonenabling for the scope of the claim because the specification disclosed at most only those means known to the inventor.). When claims depend on a recited property, a fact situation comparable to Hyatt is possible, where the claim covers every conceivable

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structure (means) for achieving the stated property (result) while the specification discloses at most only those known to the inventor. (MPEP 2164.08 (a)).

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-14, 16, 18, 24, 26, 31, 33, 35, 37, 39, 41, 43, 45 47, 50 and 51 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1 and 8, the phrase "the result of the comparison" seems to be referring to a previously cited *results* and *comparison* which does not appear in the claim. Claims 2-7, 9-14 31, 33, 35, 37, 39, 41, 43, 45 47, and 51 variously depend from an indefinite base claim and are thus themselves indefinite.

Regarding claims 16, 18, 24 and 26, the phrases "calculating the number of the iterations" and " the iterative decoder" also seem to be referring to a previously cited *iteration* and *iterative decoder*, respectively, which does not appear in the claims.

Regarding claim 50, the phrase "it is removable" is ambiguous as in what part of the elements of claim 49 is removable.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

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Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 51 and 52 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims are non-statutory because the citation "computer program product" in claims 51 and 52 is directed towards descriptive material (i.e. an analog form or digital representation, respectively). Such descriptive material can be classified as being either functional (i.e. the descriptive material imparts functionality on a generic computer when such material is embodied in the computer for example, computer programs or data structures) or non-functional (e.g. music or text). In this case, the descriptive material is none-functional because, it merely describes the data combined, used or processed. The claims do not define any functional operations or relationships that would impart functionality on a computer. The following formats are acceptable: "A computer program embodied in a computer readable medium for performing the steps of ..." or "A computer readable medium storing a program for performing the steps of". (See case law in MPEP 2106).

Allowable Subject Matter

8. Claims 1-14, 16, 18, 24, 26, 33, 37, 41, 45, 47 and 50 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action. The following is a statement of reasons for the indication of allowable subject matter: Yeung et al. (US 6,587,944) fails to *modify the decoder parameter* based on the comparison results of the extracted watermark and a known watermark of claims 1 and 8 combined with other features and elements of the claims.

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9. The following is an examiner's statement of reasons for allowance: claims 15, 17, 19-23, 25, 27-30, 34, 38, 42, 46 and 49 are allowable because, the prior art of record specifically Yeung et al. (US 6,587,944) fails to *modify the decoder parameter* based on the comparison results of the extracted watermark and a known watermark of claims 15 and 23 combined with other features and elements of the claims.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Other prior art cited

10. Prior art of record cited and not relied upon is considered pertinent to applicant's disclosure.

The US Patent 6,785,815; US Patent 6,711,710 and US Patent 6,320,829 teach watermarking related to applicant's invention as claimed.

Contact information

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shervin Nakhjavan whose telephone number is (703) 306-5916. The examiner can normally be reached on Monday through Friday from 8:00 am to 5:30 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leo Boudreau, can be reached at (703) 305-4706.

Any response to this action should be mailed to:

Assistant Commissioner for Patents
Washington, DC 20231

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Or faxed to:

(703) 872-9306 for *formal* communications, please mark "**EXPEDITED PROCEDURE**"

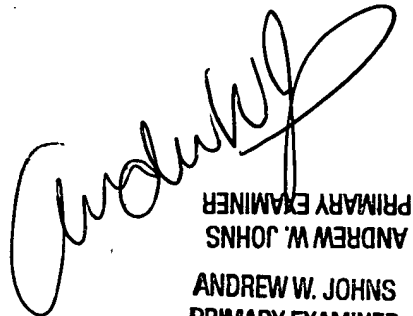
or:

for *informal* or *draft* communications; please label "**PROPOSED**" or "**DRAFT**".

Hand delivered responses should be brought to Crystal Park 2, 2121 Crystal drive, Arlington, VA, sixth floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application should be directed to the Tech center 2700 customer service office (703) 306-0377.

Shervin Nakhjavan J.N
Patent Examiner
Group Art Unit 2621
February 1, 2005.



PRIMARY EXAMINER
ANDREW W. JOHNS
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PRIMARY EXAMINER